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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,776	12/04/2003	Rajendra Sureka	JP920030202US1	7071
7590	06/04/2009		EXAMINER	
Frederick W. Gibb, III McGinn & Gibb, PLLC Suite 304 2568-A Riva Road Annapolis, MD 21401			SHIN, MIN	
			ART UNIT	PAPER NUMBER
			3688	
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			06/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/727,776	SUREKA ET AL.	
	Examiner	Art Unit	
	Min Shin	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 13 March 2009.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,6-10, 13, 18-22, 25 and 30-34 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1, 6-10, 13, 18-22, 25 and 30-34 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

1. This Office Action is in response to the Amendment filed on 3/13/2009. Applicant cancels claims 4, 5, 16, 17, 28 and 29; amends claims 1, 6-10, 13, 18-22, 25 and 30-34. Thus, claims 1, 6-10, 13, 18-22, 25 and 30-34 are currently pending and have been considered below.
2. **Examiner's Note:** Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 and 6-10 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1)

be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590). Also see *In re Bilski*, No. 2007-1130, F.3d, 2008 WL4757.

Although the applicant has attempted to overcome the rejection with the amendment, the amended claim does not overcome the previous rejection. The claims must recite a device performing a meaningful step of the claimed invention and not merely be an insignificant activity.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 6-10, 13, 18-22, 25 and 30-34 rejected under 35 U.S.C. 102(e) as being anticipated by Arganbright (US 6,980,962).

Claim 1, 13 and 25:

Arganbright discloses a method, system and a program storage device for learning consumer behavior, comprising:

- a. inputting a loaded shared business opportunity tree, wherein said SBO tree comprises: nodes, each node corresponding to a customer, said node representing a hierarchical customer-chain comprising at least one parent-child relation (Figures 2-4 and 22; column 29, lines 50-59; column 31, lines 65-67; column 32, lines 1-14).
- b. assigning transaction data, loaded in said customer node, to said parent node, wherein said transaction data comprises online transaction records between said customer and merchant; wherein said transaction relates to consumer behavior (column 15, lines 55-67, column 51, lines 23-34),
- c. setting said parent node equal to a new customer node (process where the previous customer becomes a merchant. The "IBO" disclosed by Arganbright is both the customer and the merchant).
- d. if said new customer node is not a root node, assigning transaction data to new parent node, otherwise, analyzing transaction data of all the descendants (NOTE: Claims scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP 2111.04). Therefore no patentable weight is given.

e. selecting by a said merchant, at least one product and promotional tool to be presented to customer based on transaction data relating to a consumer behavior of said all descendent nodes (column 10, lines 54-65; column 27, lines 1-17, column 41, lines 30-39; column 51, lines 23-34).

Claims 6, 18 and 30:

Arganbright discloses a method, a system and a program storage device of claims 1, 13 and 25 as described above and further discloses wherein said transaction data further comprises any of: demographics and acquaintances related to a customer (col 44, lines 56-63; col 59, lines 49-54).

Claims 7, 19 and 31:

Arganbright discloses a method, a system and a program storage device of claims 1, 13 and 25 as described above and further discloses wherein said redemption of promotional tool comprises any of: discount coupon, gift certificate, and freebies valid for particular category of items offered by said merchant (col 54, lines 50-56).

Claims 8, 20 and 32:

Arganbright discloses a method, a system and a program storage device of claims 1, 13 and 25 as described above and further discloses wherein said selecting at least one of said promotional tools for a product comprise any of: correlation analysis, collaborative filtering and associated learning (col 51, lines 23-34).

Claims 9, 21 and 33:

Arganbright discloses a method, a system and a program storage device of claims 1, 13 and 25 as described above and further discloses comprising any of: determining pricing for items offered by said merchant; performing market segmentation of said customers; identifying preferences of said customers; performing marketing targeted at an identified market segment; and maximizing the potential success of a promotional tool (see Abstract; column 10, lines 14-21; column 30, lines 37-54).

Claims 10, 22, and 34:

Arganbright discloses a method, a system and a program storage device of claims 1, 13 and 25 as described above and further discloses wherein said customer is provided incentives providing incentives to said customer to acquire descended customers (col 30, lines 1-8).

Response to Arguments

7. Applicant's arguments regarding claims 1, 6-10, 13, 18-22, 25 and 30-34 have been fully considered but they are not persuasive. Therefore, similar ground of rejection is maintained.

The applicant has argued that Arganbright is only directed to the compensation of the member and do not disclose analyzing the transaction data relation to consumer behavior of all descendants. (paragraph 0021) First, as mentioned above, the recited

claim portion is an optional claim language, therefore, no patentable weight is given. Even if some weight is given to, Arganbright clearly discloses analyzing the "purchase habits" of the users and customizing the appearance of the website (column 51, lines 23-34). The purchase behaviors of the nodes are analyzed in order to present a more attractive promotion to the potential customers. As noted above an "IBO" is both a customer and a merchant as disclosed by Arganbright.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Shin whose telephone number is (571) 270-3463. The examiner can normally be reached on Monday-Friday 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Myhre can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MS
6/2/2009

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688